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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91224807
Party	Defendant Lorne Rubinoff and Delaram Hajipour
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Nike, Inc. v. Lorne Rubinoff and Delaram Hajipour Opposition No. 91224807

ANSWER

1. The Applicants admits that the Opposer is a leading sport and fitness company, and a leading provider of a broad range of clothing, footwear, and sporting goods. The Applicants do not know that the Opposer provides related products or any services.

2. The Applicant admits that the Opposer is the owner of federal registrations and common law rights for the "JUST DO IT" and "JUST DO IT." marks (collectively the JUST DO IT Mark)..

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3.The Applicants admit the Opposer has continuously used the JUST DO IT Mark in interstate commerce since at least as early as 1989, in connection with various clothing items.

4. The Applicants admit the Opposer has continuously used the JUST DO IT Mark in interstate commerce since at least as early as 2008, in connection with eyeglasses and sunglasses.

5. The Applicants admit the Opposer has continuously used the JUST DO IT Mark in interstate commerce since at least as early as 2010, in connection with various cell phone and hand-held computing device accessories.

6. The Applicants admit the Opposer has continuously used the JUST DO IT Mark in interstate commerce since at least as early as 2011, in connection with all purpose sport bags and backpacks.

7. The Applicants admit the Opposer is the owner of the U.S. Trademark Registrations 1,875,307, 4,350,316, 4,704, 671, and 4,764,071, and that the Opposer has owned other registrations in the United States and throughout the world for the JUST DO IT Mark. The Applicants do not contest the validity of the Opposer's registrations.

8. The Applicants admit the Opposer has made substantial sales of goods under its JUST DO IT Mark, and has used the JUST DO IT Mark as a slogan in highly successful advertising and promotional campaigns over the course of many years. The Applicants do not know that the Opposer substantial sales of any services under its JUST DO IT Mark.

9. The Applicants admit the Opposer has brought numerous other successful oppositions based on the JUST DO IT Mark, including its opposition to the mark JUST JESU IT reported in Nike, Inc. v. Peter Maher and Patricia Hoyt Maher, 100 USPQ2d 1018 (TTAB 2011) and that Nike v. Maher, the Board sustained Opposer's opposition on both the grounds of likelihood of confusion with the JUST DO IT Mark and dilution, and found that O pposer's JUST DO IT Mark was famous.

10. The Applicants admit that as a result of Opposer's long use and registration of its JUST DO IT Mark, Opposer has developed substantial goodwill in said mark, and the public has come to associate the JUST DO IT Mark with the goods of the Opposer. The Applicants do not know that the public has come to associate the JUST DO IT Mark with any services of the Opposer.

11. The Applicants admit the Opposer has continuously used its "SWOOSH DESIGN"), in interstate commerce since at least as early as 1971, in connection with various items in Class 25.

12. The Applicants do not know that the Opposer has continuously used the SWOOSH DESIGN Mark in interstate commerce since at least as early as 1972, in connection with various services in Class 42.

13. The Applicants admit the Opposer is the owner of U.S. Trademark Registrations: 1,264,529, 977,190, 1,284,385, 1,323,343, 1.926,168, 1,990,180, 2,024,437, 2,107,521, 2,239,078, 1,145,473, 2,490,994, 2,522,877, 2,237,852, 2,863,049, 3,218,672 and 3,473,652, and that in addition to the registrations for the SWOOSH DESIGN Mark alone, Opposer also owns numerous registrations for marks in which the SWOOSH DESIGN is joined with other NIKE owned trademarks.

14. The Applicant does not contest the validity the Opposer's registration no.'s 1,264,529, 977,190, 1,284,385, 1,323,343, 1,990,180, 2,024,437, 2,107,521, 2,237,852, 2,239,078,

1,145,473, 2,490,994, 2,522,877, 2,237,852, 2,863,049, 3,218,672 and 3,473,652.

15. The Applicants admit the Opposer has made substantial sales of goods under its SWOOSH DESIGN Mark, and has used the SWOOSH DESIGN Mark in highly successful advertising and promotional campaigns over the course of many years. The Applicants do not know that the Opposer has made substantial sales of services under its SWOOSH DESIGN Mark, and has used the SWOOSH DESIGN Mark in highly successful advertising and promotional campaigns over the course of many years.

16. The Applicants admit that over the years, the Opposer has filed several successful opposition and cancellation proceedings based on its SWOOSH DESIGN Mark including its recent opposition to the mark ABERONI and Design (Opposition No. 91209616)
and cancellation of the registration for DON'T JUST DO IT... DO IT RIGHT. V V&V (Cancellation No 92059548) in which it prevailed in both proceedings, and that moreover, the SWOOSH DESIGN Mark has been declared "famous" [Leviton MFG. v. Universal Security Instruments, Inc. et al. 409 F. Supp.2d 643, 652 n.12 (D.Md. 2006), and that the Opposer's SWOOSH DESIGN Mark also has achieved fame internationally, and is registered in more than 100 countries and geographic regions, and is one of the most recognizable trademarks in the world.

17. The Applicants admit that as a result of Opposer's long use and registration of its SWOOSH DESIGN Mark, Opposer has developed substantial goodwill in said mark, and the public has

come to associate the SWOOSH DESIGN Mark with the goods of Opposer. The Applicants deny that as a result of Opposer's long use and registration of its SWOOSH DESIGN Mark, the Opposer the public has come to associate the SWOOSH DESIGN Mark with the services, if any, of the Opposer,

18. The Applicants admit the Applicants filed their application for Applicants' Mark on October 31, 2013, stating its intention to use the mark in connection with "Promoting the creation and sale of people-friendly and eco-friendly products of others through the operation of an online social media platform in the nature of an online marketplace for exchanging goods and services with other users" in International Class 35.

19. The Applicants admit if the Applicants are permitted to register their mark, the registration will give the Applicants a prima facie exclusive right to the use of Applicants' Mark for the goods set forth in the application. The Applicant denies that such registration would damage and injure the Opposer.

20. The Applicant denies there is a likelihood of confusion of the Applicant's proposed trademark and usage with respect to the Opposer's marks.

21. The Applicants admit the Opposer's use and registration of its JUST DO IT Mark is long prior to the filing date of the opposed Application.

22. The Applicants admit the Opposer's use and registration of its SWOOSH DESIGN Mark is long prior to the filing date of the opposed Application.

23. The Applicants admit the Applicants were aware of Opposer's JUST DO IT Mark and SWOOSH DESIGN Mark at the time that they filed their application.

24. The Applicants deny the Applicants' Mark is confusingly similar to Opposer's JUST DO IT Mark and SWOOSH DESIGN Mark.

25. The Applicants deny the Applicants' use and registration of Applicants' Mark will inevitably lead to confusion, to mistake, or to deception of the public within the meaning of Section 2(d) of the Lanham Act, 15 USC §1052(d), all to Opposer's grave and irreparable damage.

26. The Applicants deny that the registration of Applicants' Mark should be denied based on a likelihood of confusion with Opposer's prior JUST DO IT Mark and SWOOSH DESIGN Mark, in violation of Section 2(d) of the Lanham Act, 15 USC §1052(d).

27. The Applicants deny that the Opposer's marks will be diluted by the Applicant's proposed trademark and usage.

28. The Applicants admit that the Opposer's registered JUST DO IT Mark and SWOOSH DESIGN Mark, which have both been in use in commerce for more than twenty-five

years, are famous within the meaning of Lanham Act Section 43(c), 15 USC 1125(c).
The Applicant deny that this is a ground for cancellation.

29. The Applicants admit the Opposer's JUST DO IT Mark and SWOOSH DESIGN Mark became famous prior to the filing date of the application for Applicants' Mark and prior to any date of first use or first use in commerce of the Applicants' Mark.

30. The Applicants deny that the registration of Applicants' Mark is likely to cause dilution of Opposer's JUST DO IT Mark and SWOOSH DESIGN Mark, to the injury of Opposer, by lessening the capacity of Opposer's JUST DO IT Mark and SWOOSH DESIGN Mark to identify and distinguish Opposer's goods and services, in violation of Section 43(c) of the Lanham Act, 15 USC §1125(c) or by otherwise diluting or tarnishing Opposer's famous JUST DO IT Mark and SWOOSH DESIGN Mark.

31. The Applicants deny that registration of Applicants' Mark should be denied based on a likelihood of dilution of the distinctive quality of Opposer's famous JUST DO IT Mark and SWOOSH DESIGN Mark, in violation of Section 43(c) of the Lanham Act, 15 USC §1125(c).

32.. The Applicants deny that the Applicants' registration of the mark herein opposed will cause injury and damage to the Opposer's rights to its registered JUST DO IT Mark and SWOOSH DESIGN Mark and to its use thereof described above.

33. The mark for which registration is sought is very different from the Opposer's JUST DO IT mark and from its "SWOOSH" mark.

34. The check mark component in the Applicant's mark has a generic aspect as an indicator of having done something right. This meaning of a check mark predates the Opposer's existence. The Opposer ought not to have exclusive rights in check marks just because it has made famous its SWOOSH mark.

35. The Applicant's mark is for services that are very different from the Opposer's products and from the Opposer's services, if any, that are associated with the Opposer's marks.

WHEREFORE, the Applicants respectfully that the present opposition be dismissed and that the registration sought by the Applicant be allowed.

Date: December 21, 2015 By: /pdg/

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CERTIFICATE OF SERVICE

I hereby certify that on this 21st day December, 2015, a copy of the foregoing Answer was served on Opposer's counsel by first-class class mail, postage prepaid, addressed as follows to its correspondence address of record:

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